

### REMARKS

This responds to the Office Action dated August 15, 2005, and the references cited therewith.

Claims 1, 15, 26-27, 41, 52-53, 66, 79, and 80 are amended, claims 5 and 31 are canceled, and no claims are added; as a result, claims 1-4, 6-30, 32-80 are now pending in this application.

#### §103 Rejection of the Claims

Claims 1-4, 6-14, 26-30, 37-38, 40 and 52-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Barzilai et al. (U.S. 6,012,045) in view of Knight (U.S. 6,515,681).

Claims 15-25, 27-30, 32-51 and 66-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knight.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

The Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the reason that, even if combined, the cited references fail to teach or suggest all of the elements (or limitations) of the Applicant's claimed invention.

### CLAIMED FEATURES LACKING IN COMBINATION

The reference (or references when combined) must teach or suggest all the claim elements. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 1 recites:

“... the administrative note includes:

the administrative information related to the monitoring of the network-based auction facility; ...

associating the administrative note with the administrator-selected aspect of the on-line auction; and ... ” (*Applicant's claim 1, emphasis added.*)

The Office Action, in rejecting claim 1, alleges that the above limitations of claim 1 are taught by the following disclosure in Barzilai:

FIG. 5 diagrammatically illustrates a merchandise showroom screen-lobby level. This merchandise showroom can show the products either in text or by illustration. Illustrations are preferable but download time to customers must be taken into account when designing the system. Screen area 209 provides an electronic entrance way to an exemplary automobile store. The merchandise showroom screen indicates that the automobile store will be closed until July, 1997. In contrast, house or home appliances store 211 is open to customers until Jun. 15, 1997. Large appliances are open until June 10. The electronic store is open daily. The products and services offered for sale through this system are functionally grouped together. It is believed that users may browse through the merchandise showroom and select one or more items and potentially bid for the purchase of one or more items from one of these electronic stores. However, it is beneficial to show the user at the lobby level or merchandise showroom screen that the system operator sells a wide variety for products and services.

(Barzilai, col. 19, ll. 34-52)

The Applicant can find no teaching in the above-quoted text of anything that could be construed as an "administrative note" including information related to the monitoring of a network-based auction facility. At most, the above quoted text describes providing an indication of the operating hours of a particular store. This information does not relate to the monitoring of a network-based auction facility by an administrator.

Further, the Applicant points out that there is no teaching in the above-quoted text of associating an administrative note (or any other information) with an administrator-selected aspect of an online auction. There is simply no discussion of an administrator performing a selection operation, let alone a selection operation with respect to an aspect of an online auction. At most, there is some discussion as to how a lobby level or merchandise showroom screen is beneficial to show a user that a system operator sells a variety of products and services. Clearly, this is very different from associating an administrative note with an administrator-selected aspect of an online auction.

The Office Action also makes reference to the definition of the term "note" in paragraph 22 of the specification accompanying the present application. While not disputing the broader definition of the term "note", the Applicant respectfully points out that the term "note" as appears in claim 1 is qualified by the adjective "administrative" and also by the phrase "the administrative note includes... information related to the monitoring of the network-based auction facility." As such, the Applicant contends that neither Barzilai nor Knight, where the considered singularly or in combination, discloses an administrative note as required by claim 1.

Claim 1 further recites:

“... the administrative note includes... type information identifying the administrative note as being of a first type of a predetermined set of administrative note types; ...” (*Applicant's claim 1, emphasis added.*)

The Office Action concedes that Barzilai does not teach an administrative note including type information. As best can be discerned by the Applicant, the Office Action appears to contend that an "administrative note" is taught by Knight, and further that Knight also teaches "type information" identifying a note as being of a first type of a predetermined set of administrative note types. In support of this contention, the Office Action points to the following disclosures in Knight:

One of the main advantages of the present content collection/posting system is that it can be intelligently programmed to carry out message/data extraction from other online newsgroups, such as UseNet. The system can take into account a number of desired extraction parameters, including but not limited to service provider specified queries 402; auto generated community based queries 404; user customized queries 406; and content site information 408. Service provider specified queries 402 correspond generally to data filters conceived, authored, and/or formulated manually by operators associated with the service provider. These data filters can be based on the specific subject matter of the message board system, so that, for example, a data filter for a financial community is set up to look for discussions of a particular stock. Similarly, a medical community of online users might specify that materials associated with medical developments in a specific field (e.g. diabetes treatments) should be extracted. Additional data filters for additional subjects of course can be manually set up in the same fashion. As the service provider typically has some expertise in the particular area, this allows for customized data building that will likely be of interest to prospective subscribers. The service provider specified queries 402 can be set to execute periodically (i.e., daily) to update system 400 with new data using well known conventional scheduling logic.

(Knight, col. 19, ll.43-67)

The Applicant fails to discern any teaching in the above text that could be construed as "type information", much less type information that is included in a note. The above disclosure from Knight deals with a system to perform message (or data) extraction from newsgroups, such data extraction been performed utilizing filters that can be set up to identify discussions pertaining to a particular topic. This allows for customized data to be built that is likely to be of interest to subscribers to the newsgroup.

In contrast, claim 1 requires an administrative note that includes type information. Claim 1 further qualifies the type information (included within the administrative note) as

identifying the note as being of a first type of a predetermined set of note types. The Applicant can find no teaching in the above quoted text from Knight of the inclusion of type information in a note, much less of such type information identifying the note as being a first type of a predetermined set of notes.

The above arguments with respect to claim 1 of equally applicable to independent claims 26, 37, 52, 53, 66, 79 and 80, and the Examiner is respectfully requested to consider the above remarks in determining the allowability of these further independent claims.

Turning now to claim 15, this claim includes the following limitations:

“... automatically invoking a note creation function from one of a plurality of administrative applications of the network-based auction facility;

generating an administrative note via the note creation function, the administrative note including the administrative information concerning the user of the network-based auction facility, the note creation function to associate the administrative note with the user, as identified by an administrator of the network-based auction facility to the note creation function; and

storing the administrative note in a database.” (*Applicant’s claim 15, emphasis added.*)

In rejecting claim 15, the Office Action references the interface 100 shown in Fig. 1A and 1B, as well as Fig. 4 of Knight. The Applicant has below are produced the description accompanying Fig. 1A and 1B in Knight:

A conventional prior art message board is illustrated in FIGS. 1A and 1B. As seen here, an interface 100 for an internet service provider permits the user to visualize a display area 110 which includes a number of posted messages 115 for a particular subject, which, in this case, involves company A. These posted messages are generated by users having access to the website maintained by the

service provider, and can include information, commentary, etc., on any one of a variety of different subjects pertaining to company A, such as, for example, discussions of recent stock movements, products offered, press releases, etc. The users (subscribers) of the service provider compose these messages at their local computer systems, and then send (post) the same to a server at the website, where they are screened (usually for improper content), indexed (to identify topic, author, date, etc.) and stored for later retrieval by other users. Each message, therefore, is posted by a user-author within the logical area for Company A according to topic, and date, and such information is usually displayed in a region 115 of display area 110. A list of such messages, therefore, appears to the user when he/she visits the message board, and selects the logical area reserved for Company A. This list for Company A can be organized by topic, author, date, etc. by clicking an activation button associated with each of the labels "Topic," "Author" and/or "Date." An additional set of control buttons 125 can be used by the user to perform such functions as "Request" --i.e., to retrieve the message highlighted by the cursor (the entry marked in shaded form), "Create"--which allows the user to compose a new message for the topic in question, and "Find" which allows the user to search the list of messages in the topic area for selected content. As seen further in FIG. 1b, when the user Requests a particular message, display area 110 is replaced by a different display area 130, which shows the user the message entry in question. At this point, the user can read the content of the message as provided in area 135, and can then respond to the same by activating a "Reply" button 140. This has the effect, of course, of posting yet another message under the topic in question, identified with an author name corresponding to the user.

(Knight, col. 1, l. 56 – col. 2, l. 27)

The Applicant points out that the teachings of the above quoted text from Knight are limited to a message board displaying messages that have been posted by users. As argued

above, such messages are not administrative notes, which include administrative information concerning a user of a network-based auction facility.

The Applicant also disagrees with the contention in the Office Action that there is any disclosure in Knight of a "note creation function to associate the administrative note with a user, as identified by an administrator of the network--based auction facility." In support of the above contention, the Office Action makes reference to the following disclosure in Knight:

The status of the user, including whether such user is paying for subscribership or not, can also be factored into the consideration to ensure that preferred subscribers are given an appropriately weighted voice in the decisions affecting the online community.

(Knight, col. 20, ll. 35-40)

Even assuming arguendo that the messages posted to a message board, as described in Knight, were considered to be "notes", the above disclosure does not describe a function that enables a message to be associated with a user, as identified by an administrator. The above-quoted disclosure from Knight merely states that the status of the user can be considered in giving weight to decisions affecting an online community.

The Office Action further contends that certain limitations are recited only in terms of intended use, and points out that the intended use of the claimed invention must result in structural differences between the claim invention in the prior art. The "administrative note" of claim 15 is specifically recited to include "administrative information concerning the user of the network-based auction facility", and accordingly is at least structurally distinct from the prior art.

The above remarks are also applicable to a consideration of the allowability of independent claim 27, and the Examiner is respectfully requested to consider the above remarks when further examining this independent claim.



Regarding the dependent claims of the present application, a dependent claim is deemed to include all limitations of an independent claim from which it depends. Accordingly, the above remarks are also applicable to a consideration of the dependent claims of the present application.

Further, the Applicant considers the rejections of these dependent claims to be addressed by the above remarks, and has not separately addressed each of the dependent claims. This should not be construed as acquiescence by the Applicant with respect to the specific contentions provided in the Office Action against each of these dependent claims, and the Applicant reserves the right to refute these contentions.

Reservation of Rights

The Applicant does not admit that documents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such documents should not be construed as admissions that the documents are prior art.

The Office Action takes official notice of a number of issues in rejecting the claims of the present application. Applicant respectfully traverses these official notices and requests the Examiner to provide references that describe the relevant elements. Absent such references, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

**CONCLUSION**

The Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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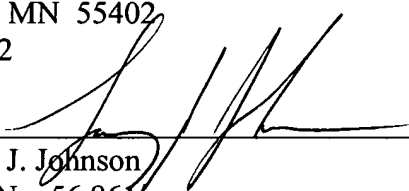
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15 day of December, 2005.

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